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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,625	01/17/2001	Qi Wang	6956CIP	5289

7590 10/02/2003  
Occidental Chemical Corporation  
Patent Department  
5005 LBJ Freeway  
Dallas, TX 75244-6119

EXAMINER
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EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 10/02/2003

60

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/761,625

Applicant(s)

WANG, QI

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25-48 is/are pending in the application.
- 4a) Of the above claim(s) 29,30,35,37,40,41 and 43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47 and 48 is/are allowed.
- 6) ☒ Claim(s) 25-27,31-34,36,38,39,42 and 44-46 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/1/03 has been entered.

### ***Election/Restrictions***

2. Claims 29, 30, 35, 37, 40, 41 and 43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of the claimed stabilizer, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 25-27, 31-34, 36, 38, 39, 42 and 44-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the stabilizer

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compounds in the examples, does not reasonably provide enablement for the multitude of stabilizer compounds of claims 25 or 44, from which the remaining claims depend.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 42 recites the limitation "said stabilizer" in claim 25, however, the stabilizers in claim 42 are not consistent with the structures of claim 25. There is insufficient antecedent basis for this limitation in the claim.

***Allowable Subject Matter***

8. Claims 47 and 48 are allowable for reasons cited in the previous actions regarding claims 20 and 21.

9. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, for reasons cited in the previous actions regarding claim 6.

***Response to Arguments***

10. Applicant's arguments filed 7/1/03 have been fully considered but they are not persuasive.

11. Regarding the 112, 1<sup>st</sup> ¶ rejections, while applicant argues that the preparation of some of the stabilized is described in page 7 of the specification, applicant is required to provide enablement for **all** of the stabilizers claimed by applicant.

Regarding the declaration, the blanket statements of generic mechanisms and allegedly commercially available compounds in the declaration by Dr. Wang are not sufficient evidence that applicant, at the time the application was filed, provided a description the enables each and every claimed stabilizer.

Applicant states that some of the stabilizers are commercially purchased, however, the mere statement that the compounds are commercially available is not evidence in itself of such for all the stabilizers.

The first paragraph of 35 U.S.C. § 112 requires a reasonable correlation between the scope of what is claimed and the scope of enablement **provided by applicant's specification** to the person of ordinary skill in the art. **There is simply no recitation in the original specification to reasonably provide enablement for *the multitude of stabilizer compounds recited in the claims*.** There is nothing of record to indicate that the person of ordinary skill in the art would be enabled by the original specification to **make and use all** the claimed stabilizer compounds, commensurate in scope with these claims. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir.

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1991); In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Applicant has not shown a representative sample of the stabilizers within the scope of the present claims.

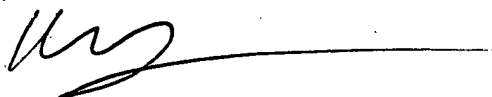
Other than some non-specific mechanisms for preparing a **small** number of the compounds applicant intends to claim and the statement that **some** other small number of the compounds applicant intends to claim are commercially available, wherein the other unidentified compounds can be made by other unidentified but allegedly well-known techniques in the art, how to prepare **all** the compounds of the rejected claims is simply not set forth in applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER



KCE